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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

MARIAM, DANIEL G

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 03/29/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,209

Applicant(s)

ZEE, PIETER J. VAN

Examiner

DANIEL G MARIAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. In response to the Office Action mailed on October 6, 2003 applicant has submitted an amendment filed on January 5, 2004 amending claims 1, 7, 9, 16, 18, 19, 25, 27, 28, and 33; and arguing to traverse the rejection of pending claims 1-34.

Response to Arguments

2. Applicant's arguments, see page 8 of the remarks, filed January 5, 2004, with respect to the rejection(s) of claim(s) 1-34 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Zimmermann, et al. (6,678,694).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 7, 9, 16, 18, 25, 27, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Zimmerman, et al. (6,678,694).

With regard to claim 1, Zimmerman, et al discloses an interactive document retrieval system that is designed to search for documents after receiving a search query from a requestor. It contains a knowledge database that contains at least one data structure which relates document word patterns to topics. This knowledge database can be derived from an indexed collection of documents (See col. 3, lines 14-20), comprising the steps of: capturing a selected portion of text

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of the information wherein the selected portion of text captured is a close-to-unique identifier of the text, i.e., word patterns and/or word(s) (See for example, "word table" in Fig. 2), and serves as a key when the information is accessed electronically, placing the key in an electronically available index to facilitate retrieval of the information (See for example, col. 9, line 23 through col. 10, line 3); and recommending topic matters that are related to the information being captured during retrieval of the information (See for example, col. 4, lines 26-58; and col. 10, line 19 through col. 11, line 38).

With regard to claim 7, the method of claim 1 wherein the recommended topic matters include at least one of related uniform resource locators (URLs) to web pages, maps, books, and related articles (See for example, item 218 in Fig. 2; item 412, in Fig. 4; and col. 11, lines 12-38).

Claim 9 is rejected the same as claim 1 except claim 9 is directed to an apparatus claim. Thus, argument analogous to that presented above for claim 1 is equally applicable to claim 9. Applicant's attention is further invited to Figure 11.

With regard to claim 16, the system of claim 9 wherein further related information is also provided that is correlated with at least one of: the key and associated information (See for example, Fig. 2).

Claim 18 is rejected the same as claim 1. Thus, argument analogous to that presented above for claim 1 is applicable to claim 18. Melen, et al further discloses a computer-readable medium having computer-executable instructions for performing steps of claim 1 (See Figure 11).

With regard to claim 25, the computer-readable medium of claim 18 wherein further related information is also provided that is correlated with at least one of: the key and associated information (See for example, Fig. 2).

Claim 27 is rejected the same as claim 18. Thus, argument similar to that presented above for claim 18 is equally applicable to claim 27. Claim 27 distinguishes from claim 18 only in that it recites placing the key in an electronically available index on a web page accessible area to facilitate search and retrieval of desired incoming information. Zimmermann, et al. (Figures 4-5, & 11) teaches this feature.

With regard to claim 33, the computer-readable medium of claim 27 wherein further related information is also provided that is correlated with at least one of: the key and associated information (See for example, Fig. 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melen, et al. (6,263,121) in view of Zimmerman, et al. (6,678,694).

With regard to claim 1, Melen, et al. (hereinafter "Melen") discloses a method for efficient information storage and retrieval of information (col. 2, lines 3-19), comprising the steps of: capturing a selected portion of text of the information, i.e., document attributes, key

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terms, words and/or text terms, wherein the selected portion of text captured is a close-to-unique identifier of the text, and serves as a key when the information is accessed electronically, placing the key in an electronically available index/directory, i.e., attribute index (170), to facilitate retrieval of the information (col. 2, lines 43-67; col. 3, lines 1-58; col. 4, lines 49-67; and col. 5, lines 15-65). Melen does not explicitly call for recommending topic matters that are related to the information being captured during retrieval of the information. However, Zimmerman, et al (See for example, col. 10, Line 40 through col. 11, line 38) teaches this feature.

Melen and Zimmerman, et al. are combinable because they are from the same field of endeavor, i.e., information/document retrieval (See for example, col. 3, lines 14-20). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Zimmerman, et al. with Melen. The motivation for doing so would at least allow narrowing down the search through dialogue and through the use of precise indexing, and to do so would at least improve the search and retrieval process (See col. 4, lines 26-48). Therefore, it would have been obvious to combine Zimmerman, et al with Melen to obtain the invention as specified in claim 1.

With regard to claim 2, the method of claim 1 wherein the information is in electronic form and the method further includes a step of storing the electronic information in a storage medium and making the electronic information available for search and retrieval using the key (See for example, col. 2, lines 43-54 of Melen).

With regard to claim 3, the method of claim 1 wherein the information is printed and the method further includes the steps of scanning and processing the information to provide an

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electronic copy of the information, storing the electronic copy of the information in a storage medium and making the electronic copy available for search and retrieval using the Key (See for example, col. 3, lines 1-12 of Melen).

With regard to claim 4, the method of claim 1 wherein the information is stored in a non-commercially accessible database (See for example, Fig. 1; and col. 4, lines 11-19 of Melen)

With regard to claim 5, the method of claim 1 wherein the information is obtained from a commercially accessible database (which reads on col. 4, lines 19-20 of Melen).

With regard to claim 6, the method of claim 1 further including, upon the user requesting retrieval of information associated with the key, providing the information associated therewith (which reads on col. 6, lines 51-67; and col. 31-34 of Melen).

With regard to claim 7, the method of claim 1 wherein the recommended topic matters include at least one of related uniform resource locators (URLs) to web pages, maps, books, and related articles (See for example, item 218 in Fig. 2; item 412, in Fig. 4; and col. 11, lines 12-38 of Zimmerman, et al.)

With regard to claim 8, the method of claim 1 further including clipping and holding the selected portion of text as a key for accessing information that is electronically available at a later date (See Figure 4 of Melen).

With regard to claim 9, an index information retrieval unit, arranged to send a selected portion of text of the information to an index storage unit, for capturing the selected portion of text of the information wherein the selected portion of text is a close-to-unique identifier of the text and serves as a key when the information is desired to be accessed electronically, the index storage unit, arranged to receive and store the key from the index information retrieval unit, for

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placing the key in an electronically available index to facilitate retrieval of the information from a storage medium that is accessible electronically, and the storage medium that is accessible electronically, wherein the storage medium is arranged to be searched using the key held in the index to identify information in the storage medium that corresponds to the key, wherein a computer unit is arranged to send and receive information from and to the index storage unit and the storage medium, and is arranged to request retrieval of information based on the key and configured for recommending topic matters that are related to the information being captured during retrieval of the information (col. 2, lines 43-67; col. 3, lines 1-58; col. 4, lines 49-67; col. 5, lines 15-65; and col. 6, lines 47-67 of Melen; and Fig. 11 of Zimmerman, et al).

Claims 10, 11, 12, and 13 are rejected the same as claims 2, 3, 4, and 5 respectively, except claims 10, 11, 12, and 13 are apparatus claims. Thus, arguments similar to those presented above for claims 2, 3, 4, and 5 are respectively applicable to claims 10, 11, 12, and 13.

With regard to claim 14, the system of claim 9 wherein the information is obtained from local accessible storage media (See for example, col. 4, lines 11-19; and Fig. 1).

Claims 15 and 17 are rejected the same as claims 6 and 8 respectively, except claims 15 and 17 are apparatus claims. Thus, arguments similar to those presented above for claims 6 and 8 are respectively applicable to claims 15 and 17.

With regard to claim 16, the system of claim 9 wherein further related information is also provided that is correlated with at least one of: the key and associated information (See for example, Fig. 2 of Zimmerman, et al).

Claim 18 is rejected the same as claim 1. Thus, argument analogous to that presented above for claim 1 is applicable to claim 18. Melen, et al further discloses a computer-readable

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medium having computer-executable instructions for performing steps of claim 1 (See Figure 1 of Melen; and Fig. 11 of Zimmerman, et al).

With regard to claim 19, the computer-readable medium of claim 18 wherein the information is in electronic form and the steps further include retrieving and indexing the information context identified by the index/directory for fast retrieval and processing (See for example, col. 3, lines 15-34; and col. 4, lines 49-61).

Claims 20, 21, 22, 23, 24, and 26 are rejected the same as claims 2, 3, 4, 5, 6, and 8 respectively. Thus, arguments analogous to those presented above for claims 2, 3, 4, 5, 6, and 8 are respectively applicable to claims 20, 21, 22, 23, 24, and 26.

With regard to claim 25, the computer-readable medium of claim 18 wherein further related information is also provided that is correlated with at least one of: the key and associated information (See for example, Fig. 2 of Zimmerman, et al).

Claim 27 is rejected the same as claim 18. Thus, argument similar to that presented above for claim 18 is equally applicable to claim 27. Claim 27 distinguishes from claim 18 only in that it recites placing the key in an electronically available index on a web page accessible area to facilitate search and retrieval of desired incoming information. Melen, et al further teaches this feature (See for example, col. 4, lines 11-25; and Fig. 4); and Zimmerman, et al. (See for example, Figures 4-5, & 11).

Claims 28, 29, 30, 31, 32, and 34 are rejected the same as claims 20, 21, 22, 23, 24, and 26 respectively. Thus, arguments analogous to those presented above for claims 20, 21, 22, 23, 24, and 26 are respectively applicable to claims 28, 29, 30, 31, 32, and 34.

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With regard to claim 33, the computer-readable medium of claim 27 wherein further related information is also provided that is correlated with at least one of: the key and associated information (See for example, Fig. 2 of Zimmerman, et al).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Numbers: 6,446,061 and 6,625,624.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DANIEL G MARIAM** whose telephone number is 703-305-4010. The examiner can normally be reached on M-F (7:00-4:30) **FIRST FRIDAY OFF**.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LEO BOUDREAU can be reached on 703-305-4607. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DANIEL MARIAM
PRIMARY EXAMINER

March 22, 2004